

## **REMARKS/ARGUMENTS**

Reconsideration and withdrawal of the rejection of the application are respectfully requested in view of the amendments and remarks herewith, which place the application into condition for allowance. The present amendment is being made to facilitate prosecution of the application.

### **I. STATUS OF THE CLAIMS AND FORMAL MATTERS**

Claims 1-13 and 15-23 are pending in this application. Claim 18 is hereby cancelled. Claims 1, 19, 20 and 22 have been amended by this response. No new matter has been introduced. Support for this amendment is provided throughout the Specification and Drawings, specifically in paragraphs 0032-0038 of the Specification as originally filed.

Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

### **II. REJECTIONS UNDER 35 U.S.C. § 103(a)**

Claims 1-13, 15 and 18-21 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over either U.S. Patent No. 3,523,867 to MacBean ("MacBean") or U.S. Patent No. 5,422,166 to Fleischer ("Fleischer") in view of U.S. Patent No. 5,558,926 to Tate et al. ("Tate").

Claims 1-13, 15 and 18-21 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over either U.S. Patent No. 4,008,801 to Reilly et al. ("Reilly").

Applicants respectfully submit that the present claims are patentable over the applied references for at least the following reasons.

#### **A. Cited references do not teach all claim recitations**

Independent claim 1 recites:

“A fabric having a fabric caliper, said fabric having a top surface coating that encapsulates fifty percent or less of the fabric caliper and said fabric comprising one or more guides attached to machine direction edges of a wear surface of the fabric so as to encapsulate approximately fifty percent or more of the fabric caliper with guide material in a region where the guide is attached to the fabric, wherein the guides are substantially v-shaped.” (Emphasis added)

Accordingly, the instant invention is directed to a fabric having a top surface coating that encapsulates fifty percent or less of the fabric caliper and comprising one or more guides attached to machine direction edges of a wear surface of the fabric so as to encapsulate approximately fifty percent or more of the fabric caliper.

As to MacBean and Fleisher, the Examiner contends on page 6 of the Action that any material located at the edge portion of the fabric can be considered a guide. Applicants strongly disagree.

Applicants submit that neither MacBean nor Fleisher have any teaching or suggestion for the use of a guide, let alone using a v-guide. MacBean discloses the use of a plastic material to interconnect the reinforcing strands with the wire, while Fleisher on the other hand teaches the use of abrasion resistant material strips for enhancing the abrasion resistance of the forming fabric. Neither of them teaches nor suggests using guides.

As to Tate, when one fills the fabric structure with the resin layer applied to the face side of the fabric to 85% of its thickness, that only leaves 15% of the structure to adequately bond the guide itself. *Tate*, col. 4, lines 40-51.

The instant invention recognizes this shortcoming of Tate which is why the face side resin layer penetrates the structure less, and the actual guide itself, when formed on the backside or drive side of the belt, penetrates further into the base structure by a factor of at least 3 versus that of Tate. It is the guide member penetration into the fabric which improves its resistance to

tearing off, and not surface side layer. Therefore, Tate does not disclose or suggest the above identified feature of claim 1.

As to Reilly, it relates to a conveyor belt guide comprising a plurality of guide sections, each including an integral polyurethane elongated rib and base web having a width substantially greater than the rib at its juncture with the web. Reilly, specifically, discloses that portions of the polyurethane are molded into the interstices of the fabric backing (32) so that the backing is securely and positively attached to the polyurethane. *Reilly*, col. 3, lines 27-42. Applicants submit that the molding into interstices of the fabric that the Examiner refers to is basically between the polyurethane and the fabric backing 32 and not between the guides 21 and the conveyer belt 16. *Id.*, Figs. 1-4.

Thus contrary to the Examiner's suggestion there is no teaching or suggestion of the above identified features in Reilly either.

B. No motivation or suggestion to combine cited references

Applicants submit that MacBean relates to a Fourdrinier wire belt having its marginal edges reinforced by a high tensile strength material strand juxtaposed to the wire and held in place by a plastic material adhering to the strand and wire. Macbean, clearly, discloses that it aims to improve the resistance of the edges of a Fourdrinier wire belt to damage and cracking without materially stiffening the belt or increasing its thickness. *MacBean*, col. 1, lines 23-25.

Therefore, the objective of both these references are contradicting each other, in that Tate teaches that polyurethane amount less than 85% tends not to result in enough bending resistant effect and satisfactory fusion to the guide protrusion, and quite contrary to Tate, MacBean teaches that it aims to improve the resistance of the edges of a Fourdrinier wire belt to damage and cracking without materially stiffening the belt or increasing its thickness. Thus one of ordinary skill in the art, while considering the teachings of one, will not look into the other,

because the objectives of both these references are contradicting to each other. Specifically, Tate and MacBean teach away from each other and thus Applicants submit that there is no motivation for one skilled in the art to combine the teachings of MacBean with Tate.

As to Fleischer, it relates to a forming fabric formed with a support surface and a running surface with the running surface having abrasion resistant areas arranged along its length adjacent each of its edges. The abrasion resistant areas comprise abrasion resistant polyurethane impregnated to penetrate and bond with and about the warp and weft filament throughout the thickness of the forming fabric.

There is no suggestion or teaching of the use of “guides” in Fleischer. Additionally, the primary objective in Fleischer is to improve the abrasion resistance of the fabric and not to install guides on the wear surface of the fabric. Therefore, there is no motivation for one of ordinary skill in the art to modify the teachings of Fleischer in view of Tate. Specifically, there is no motivation for a skilled artisan to install v-guides on the running surface of Fleischer’s fabric, when Fleischer lacks the very motivation to do so. Fleischer specifically discloses the use of “polyurethane coating” throughout its disclosure, and one of skill in the art will not be motivated to transform the “coating” of Fleischer to fabric guides in view of Tate.

MPEP §2145(X)(c) states:

As discussed in MPEP §2143.01, **there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine reference teachings.** The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references, as discussed in the aforementioned section. (Emphasis added)

The motivation or teaching to make the claimed combination by modifying or combining prior art references must be found in the prior art and not in the Applicants’ disclosure. *In re*

*Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Applicants submit that there is nothing that would motivate a skilled worker in the art to modify the teachings of MacBean or Fleischer in view of Tate or Reilly, when MacBean and Fleischer lack the very motivation to do so.

C. Impermissible hindsight reasoning and mosaic reconstruction

Applicants respectfully submit that *impermissible hindsight* reconstruction of the claimed invention using elements of the prior art is *not* allowed under 35 U.S.C. §103 (see MPEP §2142 for a discussion of impermissible hindsight).

Furthermore, MPEP §2143.01(III) states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Emphasis in original.)

Applicants respectfully submit that the Office Action has merely created a mosaic of features from the prior art, without either a clear motivation or a suggestion of the desirability of the combination.

Additionally, MPEP §2143.01(IV) states:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). (Emphasis added)

As noted above, the Office Action has merely provided references to teach individual aspects of the claimed invention in total isolation, and has not established a *prima facie* case of obvious. The Office Action has failed to provide an objective reason to *combine* the disparate

and unrelated teachings of the references into the claimed combination. Therefore, Applicants submit that the combination of references is inappropriate, and request the withdrawal of the rejections.

For at least the foregoing reasons, Applicants respectfully submit that independent claim 1 patentably distinguishes over the cited references and is therefore allowable. Claims 2-13, 15-17, and 19-23 which depend from claim 1 are allowable therewith

### **III. DEPENDENT CLAIMS**

Claims 22-23 were further rejected under 35 U.S.C. §103(a) as allegedly unpatentable over MacBean or Fleischer in view of Tate, and further in view of GB 2106557 to Curry et al. ("Curry").

Claims 22-23 were further rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Reilly in view of GB 2106557 to Curry et al. ("Curry").

The dependent claims in this application are each dependent from independent claim 1 discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

**CONCLUSION**

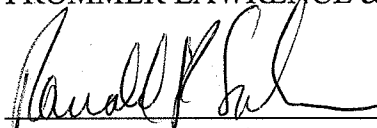
In view of the foregoing amendments and remarks, it is believed that all of the claims in this application are patentable over the prior art, and an early and favorable consideration thereof is solicited.

Statements appearing above with respect to the disclosure in the cited reference represent the present opinions of the Applicant's undersigned attorney and, in the event that the Examiner disagrees with any such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the respective reference providing the basis for a contrary view.

Please charge any fees incurred by reason of this response and not paid herewith to  
Deposit Account No. 50-0320.

Respectfully submitted,  
FROMMER LAWRENCE & HAUG LLP

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